

REMARKS

Favorable reconsideration of this application is respectfully requested.

The Title is amended by the present response to be more clearly indicative of the claimed invention, to address the objection noted in paragraph 2 of the Office Action.

Claims 1-14 are pending in this application. Claims 11-14 are allowed. Claims 1, 2, and 5-8 were rejected under 35 U.S.C. § 103(a) as unpatentable over U.S. patent 5,408,335 to Takahashi et al. (hereinafter "Takahashi") in view of JP 10-193,685 to Koyanagi et al. (herein "Koyanagi"). Claims 4 and 10 were rejected under 35 U.S.C. § 103(a) as unpatentable over Takahashi in view of Koyanagi and further in view of U.S. patent 4,894,727 to Sasaki. Claims 3 and 9 were objected to as dependent upon a rejected base claim, but were noted as allowable if rewritten in independent form to include all of the limitations of their base claim and any intervening claims.

Initially, applicants gratefully acknowledge the indication of the allowance of claims 11-14 and the allowable subject matter in claims 3 and 9.

Addressing now the rejection of claims 1, 2, and 5-8 under 35 U.S.C. § 103(a) as unpatentable over Takahashi in view of Koyanagi, and the further rejection of claims 4 and 10 further in view of Sasaki, those rejections are traversed by the present response.

Applicants respectfully submit that the outstanding rejection is not properly considering each of the claimed features. According to features set forth in the claims as currently written, an evaluation is made based on a number of lines of image data taken from a photoelectric transducer, see for example step S2 in Figure 6. That predetermined number of lines of image data taken from the photoelectric transducer can then be adjusted based on a comparison of an average value of output levels from picture elements to a predetermined target value. With reference to Figure 8 in the present specification as a non-limiting

example, if a difference between an average value of output levels from picture elements and a target value is 5 or more, a number of lines of image data taken from a photoelectric transducer is set at 4, but when the difference falls to less than 2, the number of lines of image data taken from the photoelectric transducer is adjusted, and in the specific non-limiting example shown in Figure 8 is increased to 16.

Such operations are believed to clearly distinguish over the applied art.

The outstanding Office Action first recognizes that “Takahashi does not expressly disclose an adjusting device configured to adjust the predetermined number of lines of image data taken from the photoelectric transducer on the basis of a result of the comparison”.¹ To overcome that recognized deficiency of Takahashi, the outstanding Office Action now cites the teachings in Koyanagi, and specifically states “Koyanagi discloses an adjusting device configured to adjust the predetermined number of lines of image data taken from the photoelectric transducer on the basis of the result of the comparison (Paragraph 0010). Takahashi and Koyanagi are combinable because they are from the field of image processing...The suggestion/motivation for doing so would have been since both inventions share cumulative features making them additive in nature”.²

The above-noted positions are traversed in that first they do not properly consider all of the claim features, and even if the teachings in Takahashi and Koyanagi were combined as suggested in the Office Action each of the claimed features would not be realized. Further, the Office Action has not set forth any proper motivation for combining the teachings in Takahashi and Koyanagi in the manner suggested.

¹ Office action of April 8, 2004, page 3, second paragraph.

² Office action of April 8, 2004, page 3, last four paragraphs.

Koyanagi is directed to a device that can change resolution, and particularly to a device in which after a resolution in a main scan direction is changed, a resolution in a sub-scan direction is changed.³

The outstanding Office Action cites paragraph 0010 in Koyanagi as disclosing the claimed features. However, applicants note that at that portion Koyanagi merely discloses operations for the resolution change, which feature is clearly different from the claims as clearly written.

In the claims as currently written, the predetermined number of lines of image data taken from a photoelectric transducer is changed based on a result of a comparison between *an average value of output levels* from picture elements in a predetermined number of lines of image data taken from a photoelectric transducer and a predetermined target value. That is, the claims as written are not directed to a device that changes the resolution in a main and sub-scan direction as in Koyanagi, but instead is directed to a device in which a predetermined number of lines of image data taken from a photoelectric transducer can be changed based on *comparing an average value of output levels from picture elements in a predetermined number of lines with a predetermined target value*.

What the outstanding rejection has not properly considered is how the claimed adjustment in the predetermined number of lines of image data is effectuated. In the claims that adjustment is not based on a change of a resolution in a main scan direction to thereby effectuate a change of resolution in a sub-scan direction. Instead, in the claims as currently written, a predetermined number of lines of image data taken from a photoelectric transducer is adjusted if a comparison between an average value of output levels from picture elements and a predetermined target value provides certain results. In the non-limiting example noted above with respect to Figure 8, when that difference is 5 or more, a number of lines of image

³ Abstract of Koyanagi.

data is set at 4, but when that difference falls to less than 2, the number of lines of image data taken from a photoelectric transducer is adjusted to 16. Such features clearly are neither taught nor suggested by the teachings in Koyanagi, which merely teaches to effectuate a sub-scan resolution change when a main scan resolution change is made.

Thus, even if the teachings in Koyanagi were combined with the teachings in Takahashi, such a combination would not meet the claim limitations, as such a combination would still not result in adjusting a number of lines of image data taken from a photoelectric transducer based on a comparison between an average value of output levels from picture elements in a predetermined number of lines of taken image data and a predetermined target value.

Moreover, applicants note that the outstanding rejection has not set forth any proper motivation to combine the teachings in Koyanagi to those in Takahashi. The only motivation set forth in the office action is “both inventions share cumulative features making them additive in nature”. That statement in the office action clearly does not set forth a proper *prima facie* case of obviousness. As stated in M.P.E.P. § 2143:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all of the claim limitations.

The teaching or suggestion to make the combination and the reasonable expectation of success must both be found in the prior art, not in applicants’ disclosure.

The above-noted statement that “both inventions share cumulative features making them additive in nature” does not set forth any real motivation as to why one of ordinary skill in the art would combine such teachings. The cursory stated motivation also does not set forth that there would be any expectation of achieving a successful device if such teachings

were combined. Finally, neither Takahashi nor Koyanagi themselves teach nor suggest any reason to make the noted combination.

Further, and as discussed above in detail, such a prior art combination of teachings still does not even teach or suggest all of the claim limitations.

In such ways, none of the three criteria noted above required to establish a *prima facie* case of obviousness has been established in the present application.

For such further reasons, applicants respectfully submit that the combination of teachings of Takahashi in view of Koyanagi does not meet or suggest each of the positively recited claim features.

Moreover, no teachings on Sasaki can overcome the above-noted deficiencies of Takahashi in view of Koyanagi.

In such ways, applicants respectfully submit that rejected claims 1, 2, 4-8, and 10, also patentably distinguish over the applied above.

As no other issues are pending in this application, it is respectfully submitted that the present application is now in condition for allowance, and it is hereby respectfully requested that this case be passed to issue.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.



Gregory J. Maier
Attorney of Record
Registration No. 25,599
Surinder Sachar
Registration No. 34,423

Customer Number

22850

Tel: (703) 413-3000
Fax: (703) 413 -2220
(OSMMN 08/03)

GJM/SNS/law

I:\ATTY\SNS\19'S\199921\199921US-RESP AF DUE 080804.DOC